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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,574	10/08/2003	Gary Roger Miller	58575-281077	6831

7590 03/30/2005

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EXAMINER

LE HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,574

Applicant(s)

MILLER ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 25,26 and 37-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-71 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ---
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

This is in response to Paper filed on 19 January 2005.

- I. Applicants elect the invention of Group I, claims 1-36, without traverse being acknowledged.
- II. Applicants elect the species of 2-phenoxyethanol, sodium hydroxide, diethanolamine, and sodium octyl sulfate without traverse being acknowledged. The elected species have been considered and searched. The consideration and searched are extended to the applied species. Others have not been considered, searched or examined until all of the elected and applied species are overcome. The non-elected species being disclosed, taught and suggested in Aoshima (6,740,468) are applied. Claims 25 and 26 are properly withdrawn for consideration for now because they are related to non-elected species. It is required that they are considered and searched when all of the elected and applied species are overcome.
- III. Applicants' prior art submissions filed on 17 February 2004 and 24 January 2005 have been considered.
- IV. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

Art Unit: 1752

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 and 27-36 with respect to the elected and applied species are rejected under 35 U.S.C. 102(e) as being anticipated by Aoshima (6,740,468).

Aoshima discloses and teaches a composition having a pH solution of from 9.0 to 13.5 and comprising a sufficient amount of one or more alkaline agents including the elected species of sodium hydroxide and (up to 1 wt% of diethanolamine on col.26:61-63) to provide a pH solution of from 9.0 to 13.5, up to 10 wt% of a dispersing agent and up to 5 wt% of an organic solvent including the elected 1-phenoxyethanol. Please especially see col.25:22-50, 26:48-50 and 64 to 27:63, 28:26-39 and 29:35-39, 34:46-54 and 35:10-19.

The intended use in the preamble with respect to “for...less than 13” in claim 1 has and is given no value in the above applied statutory.

In claim 5, the comparative language “greater” has and is given no value in a claimed single material (composition). It would be given full value in a method for comparison of two materials.

Aoshima does not specify the “conductivity” functional property in his aqueous composition as that in claim 5. Since Aoshima aqueous composition contains strong charge ions, such as Na⁺ and OH⁻, at the level of one skilled in the art Aoshima aqueous composition would have a strong conductivity. For a functional property of a material, it is allowed to request applicants to provide a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

Aoshima does not specify the “K_b...” functional property as that in claim 12. Since Aoshima composition contains strong base, such as NaOH, at the level of one skilled in the art

Art Unit: 1752

NaOH would have “K_b...” functional property in the claim. For a functional property of a material, it is allowed to request applicants to provide a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

Aoshima does not specify the “K_b...” functional property as that in claim 12. Since Aoshima composition contains weak base, such as diethanolamine, at the level of one skilled in the art diethanolamine would have “K_b...” functional property in the claim. For a functional property of a material, it is allowed to request applicants to provide a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

In claims 34, 35, 36 the comparative language “higher than” has and is given no value in a claimed single material (composition). It would be given full value in a method for comparison of two materials.

In claims 34, 35, 36 the processing step of use of “...it is to be added” embodiment has and is given no value in any material (composition) claim. It would be given full value in a method of use.

Since Aoshima discloses and teaches the claimed embodiments and the claimed embodiments are reasonably the same property as those in the applied compositions as clearly pointed out and set forth above, the above claims are found to be anticipated by. For a functional property of the materials, it is allowed to request applicants to provide a convincing evidence to the contrary in accordance with the authority states in *In re Schreiber*, 44 USPQ2d, 1429.

IV. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

Art Unit: 1752

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
17 March 2005

HOA VAN LE
PRIMARY EXAMINER
